

REMARKS

Claims 1-41 are pending in this application. Claims 21-39 were withdrawn from consideration. Claims 1 and 40-41 have been amended herein. Remarks regarding the Examiner's rejection of claims 1-20 and 40-41 are provided below.

The Examiner has rejected claims 1-12 and 15-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,648,315 to Yung Jen Lee ("Lee") in view of U.S. Patent No. 2,424,313 to Robert O. Heinrich ("Heinrich"). Applicants traverse such rejection.

Applicants submit that the Examiner can only combine the disclosure of Lee with Heinrich if such combination is obvious to one skilled in the art. However, Lee and Heinrich are two non-combinable references. In support of this position, Applicant first submits that apparent practical difficulties of making the substitution suggested by the Office Action while maintaining the essential functions of both devices render such a combination unobvious. Indeed, the clamping lever in Heinrich is not a brake release; it is a clamping device. This lever functions to only lock the rod when the rod is in place. Thereafter, the lever forces the jaws to close more, thereby further clamping onto any materials held by the jaws of the clamp. This lever can then be pulled to release the materials held. However, this is a completely different device than a knob (as taught by Lee) that is used solely for releasing the release panel of Lee. Indeed, the release panel of Lee is always engaged in the lock position and only is in the unlock position when the knob is pressed. Clearly, this is opposite of Heinrich. The release panels in Heinrich are always in the release position until the clamping lever locks the rod in place. With the combination of Lee and Heinrich, will the release panel always be in the lock position or the release position without action by the user? If it is the lock position, then the rod cannot freely slide without action by the user, as required by Heinrich (see Heinrich, column 3, lines 15-20). If the release panel is always in release position (without actuation required by the user), then the handgrip and the catch plate of Lee no longer operate as intended (see Lee, column 3, line 64 – column 4, line 13). Indeed, the handgrip and the catch plate are an integral parts of Lee's invention, "Clamping Device Having an Indirect Driving Mechanism". Additionally, the catch plate would still not allow for the rod to be slid in both directions and Heinrich requires the rod to be "easily slid back

and forth” (see Heinrich, column 3, lines 18-19). Clearly, the combination of Lee and Heinrich present problems and would eliminate an essential function of Lee. This is partly due to the fact that the Examiner is trying to substitute a release lever with a clamping lever. Applicant would like to remind the Examiner that the Examiner cannot simply pick and choose pieces from any one reference to make the present invention; instead, the Examiner must take each invention as a whole when combining references.

Secondly, not only do the references not teach or suggest such a combination, the references actually contain matter "teaching against" such a combination. Lee describes a device that allows the handgrip to step-by-step clamp materials disposed between the jaws. This is done by engaging a pawl and having a release panel that clamps the rod at every step, allowing for very tight clamping of the material. This is the essential invention of Lee – even listed in the title, “Clamping Device Having an Indirect Driving Mechanism.” However, Heinrich obviously teaches away from allowing the release panel or catch plate to be engaged while the rod is being slid. Instead, Heinrich teaches the release plate and catch plate must not engage the rod so that the rod is “easily slid back and forth” (see Heinrich, column 3, lines 18-19). Clearly this teaches away from combining Lee and Heinrich.

Third, Applicant submits that even if the references are combined as suggested by the Examiner, the resulting combination would not operate as intended or would be rendered inoperable – rendering such combination nonobvious. On page 2 of the Office Action, the Examiner stated, “[t]o fashion th[e] ear [of Lee] such that it extends through a slot or hole in the side of the handle would have been obvious . . .” However, if one moved the knob 42 (and corresponding slot) of Lee to the side of the handle, as suggested by the Examiner, the knob 42 would no longer actuate the release panel. This is because the knob 42 can only actuate the release panel if the knob is orientated in a direction parallel to the direction that the release panel can move – both of which must be along the same direction as the rod 20. When the knob and the release panel are orientated in the same direction as Lee requires, the knob can then exert a force against the face of the release panel, thereby moving the release panel (see Figures 3-4 of Lee). However, if the knob was placed on the side of the handle of Lee as suggested by the Examiner (via a

combination of Lee and Heinrich), the knob and the release panel would then be perpendicular to each other, thereby not allowing the knob to exert a force against the face of the release panel. If no force is exerted to the face of the release panel, the release panel will not release the rod, rendering the combination of Lee and Heinrich "inoperable for its intended purpose."

Lastly, it is submitted that the combination of Lee and Heinrich is based on the use of impermissible hindsight and is only obvious if applicant's disclosure is used as a template for the combination. One factor to consider is whether there is a teaching or suggestion to combine the references as proposed by the Examiner. In the present case there is no such teaching or suggestion in either Lee or Heinrich and it is submitted that one skilled in the art would not have found the combination of references obvious without benefit of the instant disclosure. One skilled in the tool art would clearly not have resorted to the clamping lever of Heinrich to be a brake release for the clamp in Lee.

Applicants submit that even if Lee is combined with Heinrich, as suggested by the Examiner, the resulting combination would still not teach all of the claimed elements. For example, on page 2 of the Office Action, the Examiner stated that:

"Lee shows an ear 42 that is capable of being actuated from the front and the side of the handle. To fashion this ear such that it extends through a slot or hole in the side of the handle would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Heinrich."

Applicants disagree. Applicants submit that the knob 42 of Lee is only capable of being actuated from the front of the handle, as shown in Fig. 1 of Lee. Nowhere does Lee disclose that the knob 42 is actuated anywhere other than depressing the knob from the front of the handle. This is because the knob 42 of Lee only extends toward the front of the handle and no portion of the knob 42 of Lee extends to the side of the handle.

Applicants also submit that there is no disclosure in Lee of a slot that faces in a direction that is substantially perpendicular to the support element. The only slot in Lee faces in a direction that is parallel to the rod 20 to provide access to knob 42. The Examiner looked to Heinrich to

remedy such deficiency in Lee by taking the position that the lever 40 in Heinrich "extends through a hole or slot in the side of housing . . ." (see Office Action, page 2). However, lever 40 in Heinrich does not extend through any housing and instead is connected (i.e. welded) to the shaft 34, as is illustrated in Figure 1. The only device extending through the shell 18 of Heinrich is shaft 34. However, neither the shaft nor the lever in Heinrich can be reasonably interpreted as an ear.

Further, the Examiner stated on page 4 of the Office Action that "a pin or the like can be fixed onto the side of ear 42 of Lee for the convenience of actuating ear 42 of Lee from the side." However, Applicants submit that there is no "pin or the like" disclosed in Heinrich and further, the "pin or the like" cannot be reasonably interpreted as an ear. For argument's sake, even if the pin could be interpreted as an "ear," there is no disclosure from Heinrich, or any other cited reference, of how the pin is connected to the knob 42 of Lee. There is clearly no suggestion for one to take the lever of Heinrich and somehow connect it to the knob 42 of Lee. This idea is nonsensical and one skilled in the art would simply not have any motivation to combine the clamping lever of Heinrich with the knob of Lee. Further, the Examiner stated that a slot could be included in the side of Lee (see top portion of page 3 of the Office Action). However, there is absolutely no disclosure whatsoever in Lee to include such a slot nor any disclosure in any other reference for such a slot and the Examiner did not cite any art which would suggest such a slot. As such, Applicants submit that the Examiner is using impermissible hindsight to reconstruct Applicants invention using the Applicants' claims as a template.

Additionally, Applicants have amended claims 1 and 40 to recite that the ear is actuated via a force in the same direction as the direction which the support member moves to *open* the clamping jaw. Lee does not teach such limitation. In fact, Lee teaches away from this limitation because the knob 42 of Lee is actuated by depressing the knob in the same direction as the direction which the rod moves to *close* the clamping jaw. This direction in Lee is the opposite direction as the direction of forced actuation in claims 1 and 40.

Applicants respectfully submit that Lee and Heinrich do not render independent claim 1 obvious

and thus, is allowable. Claims 2-20 depend from claim 1 and thus, are also allowable for the same reasons claim 1 is allowable.

The Examiner has rejected claims 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Heinrich and U.S. Patent No. 5,853,168 to Johannes Drake ("Drake").

Applicants respectfully traverse such rejection.

Applicants have amended claim 40 to recite that the ear is actuated via a force that is aligned in a direction that is in substantially same direction as the "first direction," where the "first direction" is the direction that the support member moves in order to open the clamping jaw. Drake clearly shows the release lever is actuated in a direction that is *opposite* to the direction which the slide bar opens the movable jaw. Neither Lee nor Heinrich disclose such limitation. Thus, for at least this reason, the combination of Lee, Heinrich and Drake does not disclose every element of claim 40 and thus, claim 40 is allowable.

With respect to claim 41, claim 41 recites that the ear is only capable of actuation from the side of the clamp body. The lever in Drake is only capable of actuation from the top of the clamp body and cannot be actuated from the side of the clamp body. Further, the lever in Drake does not translationally move from one edge of the slot to the opposite side of the slot, as recited in claim 41. Instead, the lever in Drake moves from the middle of the slot to one edge of the slot (see lever 25 in opening 44 of Figure 1 of Drake). Neither Lee nor Heinrich disclose such limitation. Thus, for at least this reason, it is submitted that the combination of Lee, Heinrich and Drake does not disclose every element of claim 41 and thus, claim 41 is allowable.

Applicants further reiterate the arguments presented above with respect to claims 1-20. In addition, Applicants submit that Drake cannot be combined with Lee and Heinrich. Such combination would certainly render Lee inoperable because the lever in Drake is a braking lever that directly contacts the slide bar and the lever in Heinrich is a clamping device – neither of which are brake releases. If the lever in Heinrich or Drake is inserted into Lee, the levers would not release the brake release of Lee, rendering Lee inoperable. Thus, it is improper to combine

Drake with Lee and Heinrich.

For at least the above reasons, it is submitted that independent claims 40-41 define over the art relied on by the Examiner and are allowable.

Applicants believe they have responded to the Examiner's concerns, and that the application is in condition for allowance. Reconsideration of this application as amended is hereby requested.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that all claims are now in condition for allowance. Accordingly, allowance of such claims is respectfully requested. If the Examiner has any questions about the present Amendment a telephone interview is requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

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